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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,857	05/03/2001	Hideki Itaya	HCD11785	9838

7590 07/13/2004

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EXAMINER

LUDLOW, JAN M

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

cf

Office Action Summary

Application No.

09/849,857

Applicant(s)

ITAYA ET AL.

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-18 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1743

1. Applicant's election with traverse of group I in the reply filed on April 23, 2004 is acknowledged. The traversal is on the ground(s) that there is no burden in examining both inventions. This is not found persuasive because the inventions have different features and limitations, requiring divergent searches, including different search terms in electronic searching, concomitant analysis of different references found in the divergent searches, and different issues in examination. Therein lies the significant burden.

The requirement is still deemed proper and is therefore made FINAL.

2. The disclosure is objected to because of the following informalities: Reference to related cases should include serial numbers, filing dates and status, if abandoned, or patent numbers if patented. In that the applications cited are subsequently incorporated by reference, this information is required for completeness of the record.

Further, the specification contains references to lowering mechanism 30 and arm 32 (e.g., p. 11, 20-25), but the figures are labeled as elements 80 and 82, respectively, and the numbers 30 and 32 are not found in the Figures. Applicant should review the specification and drawings and correct these and any other inconsistencies.

Appropriate correction is required.

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Art Unit: 1743

4. Claims 1-9 are objected to because of the following informalities: In claim 1, line 8 and claim 4, line 2, "the pipette" lacks antecedence. Appropriate correction is required.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "the transfer mechanism of the pipette" is unclear because it is unclear whether this term refers back to the previously recited transfer mechanism, or a separate transfer mechanism of a pipette. In claim 7, "of pipettes" is unclear—does applicant mean the previously recited diagnostic vessels? With respect to claims 1 and 7, the examiner notes that there is no disclosure of both pipettes and diagnostic vessels, but rather both terms have been used for the same structure in the specification.

6. Claims 1-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

7. Claims 10-18 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the invention as claimed. References cited below constitute the closest prior art and the instant claims define over these references as explained below.

9. Note that for purposes of examination, the claims have been interpreted such that "carousel" means "a rotatable circular device," in accordance with its common

Art Unit: 1743

definition, and its usage in the instant disclosure. Thus, the limitations in claims 13 and 15 to "rotatable" carousels are seen as further emphasis of this point, but are not interpreted to imply that the carousels of the remaining claims may be fixed circular structures.

10. Note that rejoinder of the method claims would be permitted **IF** applicant incorporates the limitations of the allowable apparatus claim(s) verbatim into method claims including at least one positively recited method step which defines over the mere "use" of the apparatus. Applicant is reminded that a claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Seshimoto teaches sample vessels 6 on conveyor 7 and pipettes 3 (i.e., aspiration tubes) connected to circular manifold 1 which may be rotated ([0067]). The conveyor may convey disc shaped racks [0071-0072], making obvious a circular conveyor or carousel. However, instant claims 1 and 10 require that the pipette or diagnostic vessel contact the sample tube, whereas in Seshimoto, the pipette contacts a filter inserted in the sample tube. Note that the filter of Seshimoto is not considered a

Art Unit: 1743

sample tube as claimed because it cannot contain or store sample by virtue of its open bottom end—the tube 6 contains the fluid. With respect to claim 15, transfer of fluid is not directly from the sample tube to the pipette as claimed because the filter is between the tube and the pipette.

Jordan (4325910) teaches a sample turntable 32 offset from reagent turntable 26 and reaction turntable 12, but transfer is performed by pipettes 18, 20, 22 fixed in an arc of an inner circle (i.e., not on a carousel as instantly claimed, because the fixed circle is not a conveyor).

Wakatake (5183638) teaches rotatable arms carrying pipettes over carousels for fluid transfer, but the term “carousel” in the instant claims is interpreted to define over an arm, in that the arm moves in an arc, but is not itself circular.

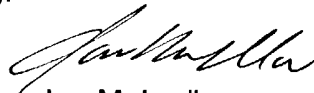
Rokugawa (4844868) teaches sample carousel 14 below reagent turntables 64, but transfer is from pipette 32 to sample tube 4, not from sample tube to pipette (diagnostic vessel) as claimed. Note further that check valves (Fig 5) prohibit transfer into the pipettes.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan M. Ludlow
Primary Examiner
Art Unit 1743

Jml
July 9, 2004